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Date Facsimile Transmitted: November 1, 2004

Attorney Docket No. 0503-002US3
Confirmation No.: 8643

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Frederick J. Murphy
Serial No: 09/877,239
Filed: June 11, 2001
Publication: US 2002/0033961 A1, published March 21, 2002
Title: Method and Apparatus for Delivery of Facsimile Documents
Over a Computer Network

Examiner: Rogers
Art Unit: 2626

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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OFFICE OF PETITIONS

PETITION UNDER 37 CFR 1.182 FOR DECLARATION
AS TO TYPE OF APPLICATION

Applicant/inventor Frederick J. Murphy respectfully requests that the Director determine whether the above-captioned application (hereafter "the '239 application") has been correctly designated a "*divisional application*," as indicated on the face of corresponding published application US 2002/0033961 A1, or whether it is actually in fact a "*continuation-in-part application*" based on added subject matter included in the '239 application but not found in the prior application. 35 U.S.C. 120; 37 CFR 1.53(b). Applicant/inventor seeks this determination to clarify whether he retains the right, initially vested in the inventor, to take action in the instant patent application. Although a prior assignment recorded against an original application would be applied to a divisional application, a continuation-in-part application requires a new assignment, and no new assignment has ever been executed or recorded in the present case. 37 CFR 3.73(b); MPEP 306, 324(II).

Date of Deposit November 1, 2004

I hereby certify that this paper is being transmitted by facsimile transmission to (703) 872-9306 according to 37 CFR 1.6(d) and 37 CFR 1.8(a)(1)(b) on the date indicated above, addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: Kay A. Herand

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This petition is appropriately submitted to the Director in keeping with the mandate of Rule 3.73(b) that the right of an assignee to take action be established to the satisfaction of the Director. 37 CFR 1.181(a)(2), 1.181(a)(3).

REMARKS

In the present petition, the Director is asked to determine whether the '239 application was correctly designated a *divisional application* (as indicated on the face of corresponding published application US 2002/0033961 A1, or whether it is in fact a *continuation-in-part application* because it contains subject matter not found in the prior application. 35 U.S.C. 120; 37 CFR 1.53(b).

For the convenience of the Director, this Petition is accompanied by the following exhibit:

Exhibit A: Order Granting Motion of Frederick J. Murphy for Relief from the Automatic Stay.

Procedural Background

1. On information and belief, the '925 application was filed on February 18, 2000, as a divisional application of US 09/184,972, filed November 3, 1998, now US Patent No. 6,028,679, issued February 22, 2000, which is a divisional of application serial no. 08/855,911, filed November 13, 1995.

2. On information and belief, the '239 application was published on March 21, 2002, as US Published Application US 2002/0033961 A1. The 'related application' data shown on the first page of the published application indicates that the '239 application claims benefit from the '925 application as a divisional application.

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3. On July 21, 2004, the undersigned, as representative for the inventor, Mr. Murphy, ordered and obtained a copy of the prosecution file wrapper for the '925 application from the US Patent & Trademark Office (hereafter "the Office"). The file wrapper included a copy of the '925 application as filed.

4. A "*Revocation Of Power Of Attorney With New Power Of Attorney And Change Of Correspondence Address*" form was executed by the inventor and filed with the Office by express mail on July 29, 2004 (hereafter "Revocation and Power of Attorney"), for the purpose of filing the instant petition and seeking the Director's review.¹

5. On information and belief, an assignment was recorded against parent application 08/855,911 at reel/frame 008316/0076, and given an effective recordation date of November 4, 1996 (hereafter "the 1996 Assignment Document"). The 1996 Assignment Document appears on its face to be a conveyance from Mr. Murphy to NetFax Incorporated of title to prior application 08/855,911, filed November 13, 1995.

6. NetFax Incorporated (the assignee of record of original parent application US serial no. 08/855,911) filed a voluntary petition for relief under Chapter 11 of the United States Bankruptcy Code on May 14, 2002, in the United States Bankruptcy Court for the District of Maryland (the "Bankruptcy Court"), Case Number 02-57777-SD. On or about June 21, 2002, the Bankruptcy Court converted the case to a Chapter 7 proceeding. The Chapter 7 trustee filed a motion in the Bankruptcy Court seeking authority to sell certain intellectual property allegedly owned by Netfax, including the '239 application.

¹ Applicant's prior representative, Mr. Peterson, was provided with a copy of the Revocation and Power of Attorney by facsimile transmission on August 4, 2004.

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7. On October 19, 2004, the Bankruptcy Court granted the inventor relief from the automatic stay to permit him to file this petition. (See, Exhibit A attached hereto.)

Type of Continuing Application under 37 CFR 1.53(b)

Applicant/inventor respectfully requests that the Director compare the disclosure of the '239 application with the disclosure of the '925 application, and make a determination as to what type of continuing application should be listed in the 'related application' data for the '239 application. Applicant/inventor submits that the '239 application includes subject matter not found in the '925 application, and thus departs substantially from the rule that the disclosure of a divisional application not include new subject matter. MPEP § 201.06. In particular, the undersigned representative of the inventor recently compared the specification and drawings of the '239 application with the specification and drawings the '925 application. Although the benefit claims published on page one of the '239 application represent that it is a divisional application of the '925 application, the published version of the '239 application includes a substantial amount of subject matter not found in the '925 application. (By way of example, the '239 application has forty-seven figure drawings, while the '925 application has only nine figure drawings. Added subject matter is also present in the specification of the '239 application.

The departure of the disclosure of the '239 application from the disclosure of the '925 application does not comply with the rules for filing divisional applications. 37 CFR 1.53(b); MPEP 201.06 (*"A "divisional" application is a later application for an independent or distinct invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application. The disclosure of a divisional application may not*

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depart from the substance of the prior application by including new subject matter.") Nor does the '239 application comply with the requirements of a regular continuation application. MPEP 201.07 ("*The disclosure presented in a continuation application must be the same as that of the original application; i.e., the continuation should not include anything which would constitute new matter if inserted in the original application.*") In contrast, a "continuation-in-part" is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier application and adding matter not disclosed in the earlier application. MPEP § 201.08. A "continuation-in-part" is the proper designation for a later application that includes any amount of newly added subject matter.

Assignment

In view of the fact that a prior assignment recorded against the original application is applied to a divisional or a continuation application while a continuation-in-part application requires a new assignment, the determination sought by this petition would further identify which party has the right to take action in prosecuting the '239 application before the Office. MPEP 306. In the present case, although the 1996 Assignment Document allegedly conveyed title to parent application 08/855,911, there is no new assignment relating to the '239 application. A decision by the Director to determine that the '239 application is, *de facto*, a continuation-in-part application due to its added subject matter would mean that the right to take action before the Office resides with the inventor.

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Disclosure Under 37 C.F.R. 1.56

In keeping with Applicant's duty of candor and good faith, the undersigned attorney, on behalf of applicant/inventor Frederick J. Murphy, wishes to inform the Director, having observed that the '239 application includes subject matter not disclosed in the prior '925 application, the applicant/inventor has a reasonable and good faith basis for believing that he holds title to the '239 application, and thus has a right to take action in the current application. On that basis, a "*Revocation Of Power Of Attorney With New Power Of Attorney And Change Of Correspondence Address*" form was executed by the inventor and filed with the Office by express mail on July 29, 2004, for the purpose of filing the instant petition and seeking the Director's review.

Notwithstanding the above, the applicant/inventor wishes to inform the Office that, with the exception of the instant petition, no amendment or other submission or action has been taken by it in the present case, no contact has been made or attempted directly with the Examiner, and no attempt has been made to alter the claims or subject matter of the application. The applicant/inventor will continue to refrain from taking any further action in the '239 application while this Petition is pending, unless events arise that would render such an action essential to avoiding abandonment of the application or preserving its status quo.

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CONCLUSION

For all of the reasons discussed above, the Director's determination as to whether the '239 application is a divisional application versus a continuation-in-part application is respectfully requested.

Please charge the petition fee pursuant to 37 CFR 1.17(h) in the amount of \$130.00, and any remaining outstanding fees or overpayments, to Deposit Account No. 50-1895, Ref. No. 0503-002US3.

Respectfully submitted:

Date: Nov. 1, 2004

Leslie Meyer-Leon
Leslie Meyer-Leon
Reg. No. 37,381

IP LEGAL STRATEGIES GROUP P.C.
P.O. Box 1210, 1480 Falmouth Road
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Telephone: 508-790-9299
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Enclosure: Exhibit A

SO ORDERED

Date signed October 19, 2004



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OFFICE OF PETITIONS

E. STEPHEN DERBY
U. S. BANKRUPTCY JUDGE

IN THE UNITED STATES BANKRUPTCY COURT
FOR THE DISTRICT OF MARYLAND
(Baltimore Division)

In re:

NETFAX, INC.,

Case No.: 02-5-7777-SD

Debtor.

* * * * *

FREDERICK J. MURPHY,

Movant,

v.

JOSEPH J. BELLINGER,
Chapter 7 Trustee, et al.,

Respondents.

* * * * *

**ORDER GRANTING MOTION OF FREDERICK J. MURPHY
FOR RELIEF FROM THE AUTOMATIC STAY**

Upon consideration of the Motion of Frederick J. Murphy for Relief from the Automatic Stay (the "Motion"); the consent of the Trustee to the relief requested in the Motion upon the terms and conditions set forth in the Stipulation by and Between Frederick J. Murphy and Chapter 7 trustee for the Consent of the Trustee to the Motion of Frederick J. Murphy for Relief

from the Automatic Stay and Withdrawal of the Objection of the Trustee Thereto filed on October 6, 2004 (Paper No. 266) (the "Stipulation"), which is incorporated herein by reference; the withdrawal of the Objection to the Motion by Firstin through counsel on the record on October 7, 2004; it appearing that cause exists to grant the Motion upon the terms and conditions set forth in the Stipulation and solely for the purpose set forth in the Stipulation; it is by the United States Bankruptcy Court for the District of Maryland, hereby,

ORDERED, that the Motion is GRANTED upon the terms and conditions set forth in the Stipulation and solely for the purpose set forth in the Stipulation.

cc:

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[END OF ORDER]